

Application No. 09/575,552

Docket No. 22-0099

REMARKS

Claims 1-21 were submitted for examination. In the aforementioned Office action, claims 1-3 and 5-10 were rejected on various grounds. Applicant notes with appreciation the allowance of claims 13-21 and the indication of allowability of claims 4, 11 and 12. Applicant respectfully traverses the rejections, for reasons explained in the following remarks.

Consistent with the Examiner's reminder concerning the proper language and format for an abstract, the abstract of the disclosure has been amended to reduce the word count and to remove possibly objectionable wording.

In sections 1 and 2 of multiple rejections under 35 U.S.C. §112, claim 8 was rejected under 35 U.S.C. §112, second paragraph, for reciting a "modifying" step without sufficient antecedent basis in the claim. The Examiner's attention is directed to the last step recited in claim 1, the parent of claim 8, where a step of "modifying the packet service schedule" is recited. Reconsideration and withdrawal of the rejection are respectfully requested.

In section 3 of the multiple Section 112 rejections, claim 8 was further rejected under 35 U.S.C. §112, first paragraph, for reciting "performing said conveying, monitoring and modifying steps on board a satellite." The comment accompanying the rejection asserts that there is no enabling disclosure of performing these steps on board a satellite. Applicant respectfully disagrees and directs the Examiner's attention to the disclosure pertaining to the apparatus of FIG. 2, in which these steps are performed. FIG. 2 is described in the Brief Description of the Drawings as "an outbound module housed within a communications satellite." The detailed description of the FIG. 2

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apparatus, beginning on page 14, line 9, of the specification, further confirms that the functions performed take place on a communications satellite. Further, it is apparent from the steps themselves that they have to be performed on a satellite. The step of "conveying packets over a downlink channel" necessarily means that the step is initiated on the satellite. The step of "monitoring at least one traffic parameter" is described as being effected by components of the FIG. 2 apparatus, which is described as being located on a satellite. Finally, the step of "modifying the packet service schedule" is necessarily performed on a satellite because the packet service schedule also is described in the context of the FIG. 2 apparatus. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-3 and 5-10 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Jorgensen (US 6,640,248) in view of Prieto, Jr. et al. (6,381,228). Both cited patents were filed before but issued after Applicant's filing date of May 22, 2000. Therefore, both patents are necessarily cited under 35 U.S.C. §102(e) in combination with 35 U.S.C. §103(a). The application from which the Prieto, Jr. patent issued was, however, commonly owned with the present invention at the time the present invention was made. Accompanying this response is a Statement Concerning Common Ownership with regard to the present application and the cited Prieto, Jr. et al. reference, US 6,381,228. Because the application from which the Prieto, Jr. et al. patent issued was commonly owned with the present invention, the Prieto, Jr. et al. patent is not a proper reference under 35 U.S.C. §103(c) / §102(e). Therefore, withdrawal of the rejection of claims 1-3 and 5-10 under 35 U.S.C. §103(a) is respectfully requested.